



RESPONSE UNDER 37 C.F.R. §1.116
- EXPEDITED PROCEDURE-
EXAMINING GROUP 2124
Attorney Docket No.: A0734.70001US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sung-Hee Do et al.
Serial No: 09/731,678
Confirmation No: 9300
Filed: December 6, 2000
For: METHOD AND APPARATUS FOR PRODUCING
SOFTWARE

Examiner: Tuan A. Vu
Art Unit: 2124

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REQUEST FOR RECONSIDERATION

Sir:

In response to the Office Action mailed May 4, 2004, Applicants respectfully request reconsideration. Claims 1, 3-15, 17-51, 53-64, and 66-95 are pending in this application and the application as presented is believed to be in condition for allowance.

Finality of the Office Action

The finality of the Office Action is improper. MPEP §706.07(a) states, "Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims** nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR

1.17(p) (emphasis added).” *See* MPEP §706.07(a), page 700-74, Original Eighth Edition, Rev. 2, May 2004.

The Office Action introduces a new ground of rejection that was neither necessitated by Applicants’ Amendment of February 17, 2004, nor based on an information disclosure statement filed by Applicants. Specifically, the Office Action rejects claims 1, 3-5, 64 and 66 under 35 U.S.C. §103(a) as purportedly being obvious over Richburg (5,159,687) in view of Kim (“Design of Software Systems based on Axiomatic Design,” Robotics & Computer Integrated Manufacturing, Vol. 8, MIT, 1991, pp. 243-255).

This new rejection is **not** necessitated by the amendments made to claims 1, 3-5, and 64 in Applicants’ previous response. Further, claim 66 was not amended in the Applicants’ previous response. The amendments made to claims 1 and 64 incorporated the limitations of previously-pending dependent claims and thus did not raise new issues that would have necessitated a new grounds of rejection. Specifically, claim 1 was amended to incorporate the limitations of previously-pending dependent claim 2 and claim 64 was amended to incorporate the limitations of previously-pending dependent claim 65. The amendments made to claims 3-5 simply changed the dependency of these claims to depend from claim 1, as amended, instead of cancelled claim 2. Additionally, claim 66 was not amended.

Because the amendments to claims 1, 3-5, and 64 did not necessitate the new grounds of rejections and because no amendment was made to claim 66, the finality of the Office Action is improper. Accordingly, it is respectfully requested that the finality of the Office Action be withdrawn and a the Office Action be treated as non-final.

Rejections Under 35 U.S.C. §103

A. Claims 1 and 64

The Office Action rejected claims 1, 3-5, 64, and 66 under 35 U.S.C. 103(a) as purportedly being obvious over Richburg in view of Kim. Applicants respectfully traverse each of these rejections, as the combination of Richburg and Kim is improper and, even if one were to combine Richburg and Kim, Applicants’ claims patentably distinguish over any such combination.